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Response to Office action dated 10-16-2003

REMARKS

Claims 1 - 60 are pending. No new matter has been added.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Claims 1 - 5, 12, 18, 27, 33 - 37, 42, 47 - 51 and 56 have been amended notwithstanding the belief that these claims were allowable. Except as specifically admitted below, no claim elements have been narrowed. Rather, cosmetic amendments have been made to the claims and to broaden them in view of the cited art. Claims 1 - 5, 12, 18, 27, 33 - 37, 42, 47 - 51 and 56 have been amended solely for the purpose of expediting the patent application process, and the amendments were not necessary for patentability.

Any reference herein to "the invention" is intended to refer to the specific claim or claims being addressed herein. The claims of this Application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this Application, except for arguments specifically directed to the claim.

Drawings

The Draftsman objected to Figures 11 and 25 under 37 CFR § 1.84 for not providing top and left margins in compliance with 37 C.F.R. 1.84(g). Substitute formal drawings are listed in the Appendix beginning at page 49.

Information Disclosure Statements

Five (5) Information Disclosure Statements have been filed in this Application. It appears that the Examiner has not yet considered IDSs filed 24 August 2001 and 22 March 2002. A copy of the 22 March 2002 IDS on a form PTO-1449 is enclosed. Consideration of this IDS is respectfully requested.

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Claim Rejections - 35 USC § 112

The Examiner rejected claims 1-23 under 35 USC § 112, first paragraph as not providing sufficient antecedent basis for the limitations "the status" and the "ad pool" in lines 5 and 15.

Claim 1, 33 and 47 have been amended to replace "the status" with "a status".

Claims 1 - 5, 12, 18, 27, 33 - 37, 42, 47 - 51 and 56 have been amended to replace "ad pool" with "ad file pool" to provide proper antecedent basis.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 1 - 6, 11 - 16, 33 - 38, 41 - 52 and 55 - 60 under 35 USC § 103 as obvious from Radziewicz et al. (Radziewicz), U.S. Patent No. 5,854,897, in view of Reilly et al. (Reilly), U.S. Patent No. 5,740,549. This rejection is respectfully traversed.

Radziewicz is directed to transmitting and displaying advertisements to a data terminal equipment (DTE) while the connection path of the DTE to a network is idle. In Radziewicz, the user of the DTE must first voluntarily subscribe to the optional advertisements. Only after the user has elected to receive advertisements will advertisements be both transmitted to the DTE and displayed on a DTE display window while the connection path is idle.

Reilly is directed to displaying a subscriber's local database of news stories and ancillary advertisements on the subscriber's screen saver after the subscriber's system has been "idle". In Reilly, "idle" refers to receiving no inputs via either keyboard or pointer device for a user configurable or otherwise specified period of time (e.g., 5 minutes) (See Reilly, 11:40-49). In Reilly, news stories and advertisements are transmitted from an information server once during the middle of the night (e.g. a randomly selected time between 11p.m. and 7a.m. local time) and once every four hours for the rest of the day (See Reilly, 8:19-24). In Reilly, the information server determines the

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"recommended download time" for news and advertisements based on the traffic of the information server (See Reilly, 14:36-44).

Claim 1:

Combination of Radziewicz with Reilly Fails to Result in the Claimed Invention:

Combining Radziewicz and Reilly would result in a system where a user may (1) elect to receive transmissions of advertisements and display the advertisements while the user's network connection is idle, and (2) (a) subscribe to an information service that transmits categorically selected news and ancillary advertisements during the middle of the night while the information server is experiencing a low traffic rate and (b) display the selected news and ancillary advertisements via a screen saver application when no inputs via either keyboard or pointer device have been received by the computer for five minutes, or another user defined period. This is not the claimed invention.

The present invention is directed to methods of downloading advertisement files when the user is not actively sending or receiving data from the network and systematically presenting the advertisement files in a viewer program window. Claim 1 comprises the following steps:

downloading ad files from the network to the user computer during such times, such that the viewer program maintains a pool of ad files at the user computer for display;

hiding the viewer program window after a predetermined number of ad files from the ad file pool have been played and keeping the viewer program window hidden for a predetermined quiet interval;

managing the ad file pool so as to keep track of the number of times each ad file in the ad file pool has been viewed and determine when each ad file in the ad file pool should no longer be viewed.

The Examiner contended that the claimed ad file pool management features were disclosed in Reilly and that it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Reilly's teachings of information and advertising

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distribution system and method with the teachings of Radziewicz, for the purpose of disseminating information and advertisements to subscriber computers in a system where the information and advertisements are automatically displayed when the subscriber's computer is on but meets predefined idleness criteria.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *MPEP* 706.02(g).

The Examiner's combination is improperly based on hindsight. At the time Radziewicz's connection path is idle, "not presently sending or receiving any information over the transmission medium" (See Radziewicz, 3:56-63), there is no suggestion or motivation in Radziewicz or Reilly to combine Reilly's scheduling and controlling of the connection manager to connect to the information server overnight and at intervals when the information server is experiencing a low traffic rate (See Reilly, 8:19-24).

Reilly's method transmits news stories and ancillary advertisements once during the middle of the night (See Reilly, 8:21) and once periodically throughout the day based on the traffic of the information server (See Reilly, 8:23 and 14:29-43: where the information server determines the next "recommended download time" to "spread" the thousands of requests per hour "fairly evenly over time"). Radziewicz teaches downloading and displaying advertisements when the connection path of the DTE to the network is idle. In Radziewicz, "idle" is the only time that advertisements are downloaded and displayed. Moreover, "idle" in Radziewicz, "a device connected to a computer or other network device by a transmission or communications medium is not presently sending or receiving any information over the transmission medium" (See Radziewicz, 3:57-63), is fundamentally different from "idle" in Reilly, "receiving no inputs via either keyboard or pointer

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device for a user configurable or otherwise specified period of time (e.g., 5 minutes)” (See Reilly, 11:40-49). Thus, Radziewicz and Reilly are incompatible.

Even if the features of Radziewicz and Reilly were combinable, they would still fail to teach each and every feature of the claimed invention. The Examiner contended that Radziewicz, at 10:39, teaches “downloading ad files from the network to the user computer during such times, such that the viewer program maintains a pool of ad files at the user computer display.” The Examiner’s analysis is incorrect. Radziewicz teaches that “advertisements and announcements [are] stored in the storage device 42 of the announcement server 30” (See Radziewicz, 10:34-36). Radziewicz also teaches “that each [Network Service Provider] NSP 16 will have its own announcement server 30 coupled thereto for transmitting messages to individual NSP subscribers” (See Radziewicz, 6:51-54). Therefore, Radziewicz teaches storing the ad files at the announcement server, not the user computer.

The Examiner contended that Radziewicz, at 24: 27-45, teaches “hiding the viewer program window after a predetermined number of ad files from the ad file pool have been played and keeping the viewer program window hidden for a predetermined quiet interval.” The Examiner’s analysis is incorrect. Radziewicz teaches that the advertisement “disappears whenever the connection path 20 is otherwise busy” (See Radziewicz, 24:37-39). Radziewicz’s trigger for disappearance is “the connection path 20 is otherwise busy.” The claimed invention keeps the view program window hidden for a predetermined quiet interval after a predetermined number of ad files from the ad file pool have been played. Radziewicz’s disappearance whenever the connection path is otherwise busy cannot be reasonably interpreted as teaching the claimed invention’s hiding feature.

The Examiner contended that Reilly, at 6:17-61, teaches “performing pool management tasks and managing the ad file pool so as to keep track of the number of times each ad file in the ad file pool has been viewed and determine when each ad file in the ad file pool should no longer be viewed.” The Examiner’s analysis is incorrect. Reilly’s administration manager 180 merely schedules the connection of the subscriber’s computer to the information server and then manages

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the connection between the subscriber's computer and the information server (See Reilly, 6:37-45).
Reilly's administration manager simply does not teach the claimed invention's ad pool management features.

The combination of Radziewicz and Reilly fails to disclose the claimed features:

downloading ad files from the network to the user computer during such times, such that the viewer program maintains a pool of ad files at the user computer for display;

hiding the viewer program window after a predetermined number of ad files from the ad file pool have been played and keeping the viewer program window hidden for a predetermined quiet interval;

managing the ad file pool so as to keep track of the number of times each ad file in the ad file pool has been viewed and determine when each ad file in the ad file pool should no longer be viewed.

Therefore, Radziewicz, in view of Reilly, does not render the claimed invention obvious. Therefore, it is respectfully requested that the Examiner withdraw the rejection for claim 1 and allow the claim to issue.

References Are Not Properly Combinable or Modifiable if Their Intended Function Is Destroyed:

It is improper to use a modification of Radziewicz with features of Reilly as the basis for a 35 USC § 103 rejection. If a person of ordinary skill in the art would modify the features of Radziewicz with the features of Reilly, the intent, purpose and function of Radziewicz would be destroyed.

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Radziewicz specifically identifies utility in being able to

productively occupy the time that the user and/or the calling station equipment is connected to a network service provider, but idle, without annoying the user by requiring the user to view a nearly meaningless status message, or wait idly while the other station processes information

(Radziewicz 1:40-45) and "have a communications system which would fill idle line time with a series of pre-recorded announcements which would provide the waiting user with useful information" (Radziewicz, 1:49-52). Moreover, Radziewicz touts its invention as

a network communications marketing system which provides announcements to a station whenever the station or line connecting the station to a communications network is idle . . . The announcements are provided until the station or line is no longer idle. At that time, the announcements are discontinued, suspended, or terminated, and may be restarted or reinitiated at a later time

(Radziewicz, 2:3-8).

Radziewicz defines "idle" as "not presently sending or receiving any information over the transmission medium" (See Radziewicz, 3:56-63). Reilly defines "idle" as "receiving no inputs via either keyboard or pointer device for a user configurable or otherwise specified period of time (e.g., 5 minutes)" (See Reilly, 11:40-49). Radziewicz's "idle" and Reilly's "idle" are fundamentally different. Radziewicz downloads and displays advertisements when the user computer's network connection is Radziewicz idle. However, Reilly teaches that (1) the downloading process is accomplished once during the middle of the night (See Reilly, 8:21) and once periodically throughout the day based on the traffic of the information server (See Reilly, 8:23 and 14:29-43: where the information server determines the next "recommended download time" to "spread" the thousands of requests per hour "fairly evenly over time") and (2) the displaying process is performed when Reilly's "system detects a lack of user inputs via either keyboard or pointer device for a user configurable or otherwise specified length of time" (See Reilly, 11:43-46).

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If Radziewicz was modified consistent with Reilly's downloading and displaying, then Radziewicz could not achieve the utility of "productively occupying" Radziewicz's idle time since it would need to wait until either the middle of the night or some Reilly "recommended time" when the network traffic at Reilly's information server is not high. The resultant would be that Radziewicz's idle time would remain "unproductive" and "annoying".

Therefore, it is respectfully requested that the Examiner withdraw the rejection for claim 1 and allow the claim to issue.

Claim 2:

Claim 2 is dependent from claim 1. Therefore, claim 2 should be allowed to issue for the same reasons as claim 1.

The Examiner contended that Radziewicz, at 15:35-67 and 16:1-26, teaches the claimed feature, "an ad file should not be viewed after the ad file has been viewed a predetermined number of times." There is nothing in Radziewicz, at 15:35-67 and 16:1-26, that even remotely relates to the feature in claim 2. Hence, even if claim 1 was obvious from Radziewicz, in view of Reilly, the Examiner has not made a *prima facie* case of obviousness with regard to claim 2. Therefore, claim 2 should be allowed to issue.

Claim 3:

Claim 3 is dependent from claim 1. Therefore, claim 3 should be allowed to issue for the same reasons as claim 1.

The Examiner contended that Radziewicz, at 14:61-67, 15:1-53, and TABLE 2, teaches the claimed feature, "determining that an ad file should not be viewed after the ad file has been viewed for a predetermined number of calendar days." There is nothing in Radziewicz, at 14:61-67, 15:1-53, and TABLE 2, that even remotely relates to the feature in claim 3. Hence, even if claim 1 was

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obvious from Radziewicz, in view of Reilly, the Examiner has not made a *prima facie* case of obviousness with regard to claim 3. Therefore, claim 3 should be allowed to issue.

Claim 4:

Claim 4 is dependent from claim 1. Therefore, claim 4 should be allowed to issue for the same reasons as claim 1.

The Examiner contended that Reilly, at 10:38-41, teaches the claimed feature "discarding an oldest ad file from the ad pool if the ad pool size exceeds a predetermined size limit value." There is nothing in Reilly, at 10:38-41, that even remotely relates to the feature in claim 4. Hence, even if claim 1 was obvious from Radziewicz, in view of Reilly, the Examiner has not made a *prima facie* case of obviousness with regard to claim 4. Therefore, claim 4 should be allowed to issue.

Claim 5:

Claim 5 is dependent from claim 1. Therefore, claim 5 should be allowed to issue for the same reasons as claim 1.

The Examiner took Official Notice under MPEP 2144.03 with regard to the claimed feature, "managing the ad pool includes not tracking an ad file as having been viewed if the viewing of the ad file is prematurely halted before normal completion."

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). *MPEP 2144.03*.

Because the Examiner has not made a *prima facie* case of obviousness with regard to "managing the ad pool", it follows that the claimed feature, "wherein managing the ad pool includes

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not tracking an ad file as having been viewed if the viewing of the ad file is prematurely halted before normal completion", does not meet the Official Notice requirement that "facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." *MPEP 2144.03*. Hence, even if claim 1 was obvious from Radziewicz, in view of Reilly, the Examiner has not made a *prima facie* case of obviousness with regard to claim 5. Therefore, claim 5 should be allowed to issue.

Claims 6 and 11 - 14:

Claims 6 and 11 - 14 are all dependent from claim 1. Therefore, claims 6 and 11 - 14 should be allowed to issue for the same reasons as claim 1.

Claim 15:

Claim 15 is dependent from claim 1. Therefore, claim 15 should be allowed to issue for the same reasons as claim 1.

The Examiner contended that Reilly, at 5:60-67 and 6:1-10, teaches the claimed feature, "wherein the viewer program tracks the number of online network access sessions by the user computer." Although Reilly, at 5:60-67 and 6:1-10, does discuss statistics of the specific advertisement files that were viewed, it does not discuss the claimed feature. Hence, even if claim 1 was obvious from Radziewicz, in view of Reilly, the Examiner has not made a *prima facie* case of obviousness with regard to claim 15. Therefore, claim 15 should be allowed to issue.

Claim 16:

Claim 16 is dependent from claim 1. Therefore, claim 16 should be allowed to issue for the same reasons as claim 1.

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Claims 33 – 38:

The Examiner (a) asserted that claims 33 – 38 have similar limitations as claims 1-6 and (b) rejected claims 33 – 38 “under the same rationale as discussed above.” Since the Examiner’s rationale was incorrect above, it is incorrect with regard to claims 33 – 38. Therefore the Examiner has not made a *prima facie* case of obviousness and claims 33 – 38 should be allowed to issue.

Claims 41 – 46:

The Examiner (a) asserted that claims 41 – 46 have similar limitations as claims 1 and 11 – 16 and (b) rejected claims 1 and 11 – 16 “under the same rationale as discussed above.” Since the Examiner’s rationale was incorrect above, it is incorrect with regard to claims 41 - 46. Therefore the Examiner has not made a *prima facie* case of obviousness and claims 41 - 46 should be allowed to issue.

Claims 47 – 52:

The Examiner (a) asserted that claims 47 – 52 list all the same elements of claim 1 – 6, but in program product form rather than method form and (b) rejected claims 47 – 52 “under the same rationale as discussed above.” Since the Examiner’s rationale was incorrect above, it is incorrect with regard to claims 47 - 52. Therefore the Examiner has not made a *prima facie* case of obviousness and claims 47 - 52 should be allowed to issue.

Claims 55 – 60:

The Examiner (a) stated that claims 55 – 60 list all the same elements of claims 11 – 16, but in program product form rather than method form and (b) rejected claims 55 – 60 using the same “supporting rationale of the rejection of claims 11 – 16.” Since the Examiner’s supporting rationale for claims 11 – 16 was incorrect, it is incorrect with regard to claims 55 – 60. Therefore the

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Examiner has not made a *prima facie* case of obviousness and claims 55 - 60 should be allowed to issue.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 7 - 10, 17 - 32, 39, 40, 53, and 54 under 35 USC § 103 as obvious from Radziewicz, in view of Reilly and further in view of Rainis et al. (Rainis), U.S. Patent No. 6,310,873. This rejection is respectfully traversed.

Rainis is directed to a system for making telephone calls via the internet. In Rainis, the calling party may select an internet telephony service prior to initiation of a call based on price, terms and conditions. In Rainis, the calling party may pay a pre-determined charge in advance of a call via credit card, smart card, or electronic cash. During the call, both the calling party and the service provider may securely monitor the duration of the call with respect to the pre-payment and the time unit cost of the call. Should the call duration approach the paid duration limit, the calling party may authorize additional payment via the internet or either the calling party or the service provider may terminate the call.

Claim 7:

Combination of Radziewicz with Reilly and with Rainis Fails to Result in the Claimed Invention:

Combining Radziewicz and Reilly would result in a system where a user may (1) elect to receive transmissions of advertisements and display the advertisements while the user's network connection is idle, (2) (a) subscribe to an information service that transmits categorically selected news and ancillary advertisements during the middle of the night while the information server is experiencing a low traffic rate and (b) display the selected news and ancillary advertisements via a screen saver application when no inputs via either keyboard or pointer device have been received by the computer for five minutes, or another user defined period, and (3) (a) perform an internet search of low rate internet telephony service providers, (b) make a pre-payment authorization for an internet

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voice communication, (c) initiate an internet voice communications with a traditional telephone number or a network computer, and (d) monitor the real time cost expenditure of the internet voice communication. This is not the claimed invention.

The present invention is directed to methods of downloading advertisement files when the user is not actively sending or receiving data from the network and systematically presenting the advertisement files in a viewer program window.

The Examiner contended that it would have been obvious of one of ordinary skill in the networking art at the time the invention was made to have incorporated Rainis' teachings of telephonic communications over the internet with the teachings of Radziewicz-Reilly, for the purpose of providing a secure payment model between client software and a server in order to be able to monitor interaction between a client and a server.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *MPEP 706.02(g)*.

The Examiner's combination is improperly based on hindsight. At the time Radziewicz's connection is idle, waiting for an event from a user selected network computer, Radziewicz is not sending or receiving any information over the transmission medium to or from a user selected network computer. During Radziewicz's idle time, the advertisements are transmitted and displayed. There is nothing in Radziewicz, Reilly, or Rainis that suggests or motivates one of ordinary skill in the art to combine Rainis's internet voice communication processes at the time when Radziewicz's system is idle (waiting for an event from a user selected network computer), and receiving and displaying advertisement files.

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In fact, Radziewicz teaches away from combining Rainis's fraud control, real time monitoring of the internet call duration and cost accounting displayed at both the calling party and the service provider with Radziewicz's transmission and display of advertisements while Radziewicz's DTE is idle. In Radziewicz, the transmission and display of advertisements occurs only if Radziewicz's user selectively chooses to receive free advertisements while it is waiting for another network computer to transmit requested information. Rainis presumes that information being transmitted, internet telephony, comes at a cost, and that the accumulating charges are monitored as they accrue. There simply can be no cost accumulation fraud when Radziewicz's information server transmits and displays advertisement files, because at that time, Radziewicz is not communicating with the network computer that Radziewicz's user attempted to connect to.

Even if the features of Radziewicz, Reilly, and Rainis were properly combinable, they would still fail to teach each and every feature of the claimed invention. Claim 7 is dependent from claim 1. The Examiner has not provided anything within Rainis to overcome the failure of Radziewicz and Reilly to teach each and every feature of the claimed invention. Therefore, claim 7 should be allowed to issue for the same reason as claim 1.

The Examiner contended that Rainis, at 7:15-25 and 3:35-54, teaches the claimed feature,

periodically performing fraud control, wherein the viewer program sends a pulse message to the access control system at predetermined intervals, and the access control system causes the communication link to the network to be severed if it fails to receive an expected pulse message.

The Examiner's analysis is incorrect. Rainis, at 7:15-25, discusses "heartbeat packets . . . contain[nig] the identification number of the conversation, along with an indication of the ongoing length of the call." Although the heartbeat packets may be encrypted, the encryption of the heartbeat packets is to prevent third parties from intercepting the information within the heartbeat packets. Moreover, the purpose of the "heartbeat packets" is for the client software to provide the user with "an indication of the amount of time spent on the call and the running cost" (See Rainis, 7:33-35).

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Rainis, at 3:35-54, discusses a secure payment model for the internet telephone call. Nothing in Rainis, at 7:15-25 or 3:35-54, relates to the pulse message of the claimed invention. Therefore the rejection for claim 7 should be withdrawn and claim 7 should be allowed to issue.

References Are Not Properly Combinable or Modifiable if Their Intended Function Is Destroyed:

It is improper to combine features of Radziewicz and Rainis as the basis for a 35 USC § 103 rejection. If a person of ordinary skill in the art would combine the features of Radziewicz with the features of Rainis, the intent purpose and function of both Radziewicz and Rainis would be destroyed.

Radziewicz specifically identifies utility in being able to

productively occupy the time that the user and/or the calling station equipment is connected to a network service provider, but idle, without annoying the user by requiring the user to view a nearly meaningless status message, or wait idly while the other station processes information

(See Radziewicz, 1:40-45) and "have a communications system which would fill idle line time with a series of pre-recorded announcements which would provide the waiting user with useful information" (See Radziewicz, 1:49-52). Moreover, Radziewicz touts its invention as

a network communications marketing system which provides announcements to a station whenever the station or line connecting the station to a communications network is idle . . . The announcements are provided until the station or line is no longer idle. At that time, the announcements are discontinued, suspended, or terminated, and may be restarted or reinitiated at a later time

(See Radziewicz, 2:3-8).

Radziewicz's "idle", "not presently sending or receiving any information over the transmission medium", is in direct conflict with a specifically touted advantage of Rainis.

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Rainis, at 3:9-11, specifies utility in the Summary of the Invention section: "It is another object of the invention to allow a calling party to make a decision as to which service, of presently available telephony services, to use during the call." Moreover, the specific process is described at Rainis, 10:40-43: "The Connection Client 94 obtains the receiving party's phone number from the user, retrieves the list of available telephony servers and their rates, and establishes a connection with the selected telephony server."

If Radziewicz's user of the DTE connected to Rainis's internet telephony system, Radziewicz's user would necessarily connect to a "presently available" service resulting in no idle time and therefore no transmission and no display of advertisements.

Therefore, it is respectfully requested that the Examiner withdraw the rejection for claim 7 and allow the claim to issue.

Claim 8:

Claim 8 is dependent from claim 7. Therefore, claim 8 should be allowed to issue for the same reasons as claim 7.

The Examiner contended that Radziewicz, at 7:18-54, discloses the claimed feature,

the viewer program maintains an ad information table that includes ad file information initially received from the access control system, such that the viewer program compares actual ad file information determined by the user computer with corresponding ad file information in the table,

and relies on the rejection of claim 7 for the claimed feature, "and such that the access server causes the communication link to the network to be severed if there is a discrepancy." The Examiner's analysis is incorrect. Radziewicz, at 7:18-54, discusses the announcement server 30, which is part of the Network Service Provider, not the viewer program. Since the ad information table is maintained in Radziewicz's announcement server 30, it cannot be co-located with the claimed viewer program. Moreover, the rationale for the claim 7 rejection is incorrect. Hence, even if claim 7 was obvious

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from Radziewicz in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 8. Therefore, claim 8 should be allowed to issue.

Claim 9:

Claim 9 is dependent from claim 7. Therefore, claim 9 should be allowed to issue for the same reasons as claim 7.

The Examiner relies on the rejection of claims 7 and 8 for teaching the claimed feature, "wherein the fraud control comprises comparing ad information in the local database with actual ad file information for the corresponding ad file, and indicating fraud if there is a discrepancy." Since the rejections of claim 7 and 8 was improper, the rejection of claim 9 is improper. Therefore, claim 9 should be allowed to issue.

Claim 10:

Claim 10 is dependent from claim 7. Therefore, claim 10 should be allowed to issue for the same reasons as claim 7.

The Examiner contended that Rainis, at 7:20-24, teaches the claimed feature, "wherein the viewer program terminates the network connection if fraud is indicated." The Examiner's analysis is incorrect. "Fraud", as defined by Rainis, at 7:15-24, relates to encrypting and digitally signing "heartbeat packets" which contain the identification number of the conversation, along with an indication of the ongoing length of the call. Rainis's fraud is not the fraud discussed in the claimed invention. Hence, even if claim 7 was obvious from Radziewicz in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 10. Therefore, claim 10 should be allowed to issue.

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Claim 17:

Claim 17 is dependent from claim 1. Therefore, claim 17 should be allowed to issue for the same reasons as claim 1.

The Examiner contended that Reilly, at 7:45-54, teaches the claimed feature, "verifying demographic information for the identified user stored at the access control system and providing the communication link." The Examiner's analysis is incorrect. Reilly, at 7:45-54, discusses "a set of procedures that define and update the subscriber's profile . . . [with regard to] . . . a subscriber identifier [and] a connection password." Reilly, at 7:45-54, does not discuss a verification process. Moreover, the subscriber identifier and connection password of Reilly are not indicative of "demographic information" of the claimed invention.

The Examiner further contended that Reilly, at 7:49-67 and 8:1-19, teaches the claimed feature, "collecting demographic information from the user computer in an initial registration and access operation, storing the demographic information at the access control system and identifying it with the registered user, and providing the communication link." The Examiner's analysis is incorrect. Although Reilly, at 7:49-67 and 8:1-19, does describe a database containing "preferences information that identifies categories and subcategories of news stories that the subscriber does not want to view", it does not describe the claimed feature. Categories of news stories that the subscriber does not want to view is not "demographic information" of the claimed invention. Moreover, there is no teaching at all of identifying the demographic information with the registered user and providing the communication link.

Furthermore, the Examiner failed to address the claimed feature "otherwise terminating the communication link and denying network access."

Hence, even if claim 1 was obvious from Radziewicz in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 1. Therefore, claim 17 should be allowed to issue.

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Claim 18:

Claim 18 is dependent from claim 17. Therefore, claim 18 should be allowed to issue for the same reasons as claim 17.

Claim 19:

Claim 19 is dependent from claim 18. Therefore, claim 19 should be allowed to issue for the same reasons as claim 18.

The Examiner contended that Reilly, at 6:1-10, teaches the claimed feature, "preparing a Demographic Report that summarizes the reported ad impression viewing data for multiple computer users over a current time period." The Examiner's analysis is incorrect. Reilly, at 6:1-10, discusses collecting ad impression data for a computer user. It does not discuss preparing a **Demographic Report** that summarizes the reported ad impression viewing data for **multiple computer users** over a current time period. Hence, even if claim 18 was obvious from Radziewicz in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 19. Therefore, claim 19 should be allowed to issue.

Claim 20:

Claim 20 is dependent from claim 19. Therefore, claim 20 should be allowed to issue for the same reasons as claim 19.

The Examiner took Official Notice to the claimed feature, "providing the Demographic Report to a computer user identified as an ad file sponsor." The Examiner nakedly asserted, "see also Gerace, U.S. Patent No. 5,848,396, whereas it discloses a sponsor object in relation to a user". The Examiner's rejection is improper.

Because the Examiner has not made a *prima facie* case of obviousness with regard to "providing the **Demographic report**", it follows that the claimed feature, "providing the

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Demographic Report to a computer user identified as an ad file sponsor”, does not meet the Official Notice requirement that “facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” *MPEP 2144.03*. Moreover, the naked Gerace assertion provides no nexus to the claimed invention to understand the basis for the rejection. Hence, even if claim 19 was obvious from Radziewicz, in view of Reilly, and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 20. Therefore, claim 20 should be allowed to issue.

Claim 21:

Claim 21 is dependent from claim 19. Therefore, claim 21 should be allowed to issue for the same reasons as claim 19.

The Examiner contended that Reilly, at Figure 5, teaches the claimed feature, “the Demographic Report includes demographic report fields that are selected by the computer user.” The Examiner’s analysis is incorrect. Reilly’s Figure 5 merely shows sports categories. There is nothing in Reilly’s Figure 5 that even remotely relates to the claimed demographic report. Hence, even if claim 19 was obvious from Radziewicz, in view of Reilly, and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 21. Therefore, claim 21 should be allowed to issue.

Claim 22:

Claim 22 is dependent from claim 19. Therefore, claim 22 should be allowed to issue for the same reasons as claim 19.

The Examiner contended that Reilly, at 6:1-10, teaches the claimed feature, “wherein providing the Demographic Report includes providing archival reports for prior time periods.” The Examiner’s analysis is incorrect. There is nothing in Reilly, at 6:1-10, that even remotely relates to the claimed feature. Hence, even if claim 19 was obvious from Radziewicz, in view of Reilly, and

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further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 22. Therefore, claim 22 should be allowed to issue.

Claim 23:

Claim 23 is dependent from claim 19. Therefore, claim 23 should be allowed to issue for the same reasons as claim 19.

The Examiner contended that the claimed feature, "adding the ad file to a playlist for each registered computer user if the ad file is matched to the computer user demographic information and if the identified time period is available for the computer user", is taught based on the same rationale as the claim 17 rationale for rejection. Since the claim 17 rejection rationale was incorrect, it is incorrect here as well. Hence, even if claim 19 was obvious from Radziewicz, in view of Reilly, and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 23. Therefore, claim 23 should be allowed to issue.

Claim 24:

The Examiner contended that Radziewicz, at 6:13-16, teaches the claimed feature, "wherein the user requests are generated by a viewer program of the user computer after detecting times when the user is not actively sending or receiving data from the network." The Examiner's analysis is incorrect. Radziewicz, at 6:13-16, discusses processes of the advertisement server 30 which resides at the Network Service Provider, not the user computer. Therefore, Radziewicz, at 6:13-16, does not teach the claimed feature, "wherein the user requests are generated by a viewer program of the user computer after detecting times when the user is not actively sending or receiving data from the network."

The Examiner contended that Radziewicz, at 10:39, teaches the claimed feature, "such that the viewer program maintains a pool of ad files at the user computer for display". The Examiner's analysis is incorrect. Radziewicz, at 10:39, discusses the storage device 42 of the announcement

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server 30 which reside at the Network Service Provider, not the "user computer" as in the claimed feature. Therefore, Radziewicz does not teach the claimed feature, "such that the viewer program maintains a pool of ad files at the user computer for display."

The Examiner contended that Reilly, at 6:17-61, teaches the claimed feature, "and performs ad pool management tasks." The Examiner's analysis is incorrect. Reilly's administration manager 180 merely schedules the connection of the subscriber's computer to the information server and then manages the connection between the subscriber's computer and the information server (See Reilly, 6:37-45). Reilly's administration manager simply does not teach the claimed invention's ad pool management features.

The Examiner contended that Rainis, at 7:15-25, teaches the claimed features, "wherein the viewer program sends a pulse message to the access control system at predetermined intervals, and the access control system causes the communication link to the network to be severed if it fails to receive an expected pulse message." The Examiner's analysis is incorrect. Rainis, at 7:15-25, discusses "heartbeat packets . . . contain[nig] the identification number of the conversation, along with an indication of the ongoing length of the call." The purpose of the "heartbeat packets" is for the client software to provide the user with "an indication of the amount of time spent on the call and the running cost" (See Rainis, 7:33-35). The "heartbeat packets" of Rainis, at 7:15-25, are wholly unrelated to the pulse message of the claimed invention.

The Examiner contended that the claimed feature, "further wherein the viewer program maintains an ad information table that includes ad file information initially received from the access control system", is taught under the same rationale for rejection as claim 17. Since the rejection rationale for claim 17 was incorrect, it is incorrect here as well.

The Examiner contended that the claimed feature, "such that the viewer program compares actual ad file information determined by the user computer with corresponding ad file information in

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the table", is taught under the same rationale for rejection as claim 7. Since the rejection rationale for claim 7 was incorrect, it is incorrect here as well.

The Examiner contends that the claimed feature, "and such that the access server causes the communication link to the network to be severed if there is a discrepancy", is taught based on the same rationale for rejection as claims 7 and 8. Since the rejection rationale of the claim 7 and 8 rejections are incorrect, they are incorrect here as well.

The Examiner has not shown that each and every claimed feature of claim 24 is taught by the combination of Radziewicz, Reilly, and Rainis. Therefore the Examiner has failed to make a *prima facie* case for an obviousness rejection. Hence, the rejection should be withdrawn and claim 24 should be allowed to issue.

Claim 25:

Claim 25 is dependent from claim 24. Therefore claim 25 should be allowed to issue for the same reasons as claim 24.

The Examiner contended that the claimed feature, "wherein the access control server compares ad information in the local database with actual ad file information for the corresponding ad file, and indicates fraud if there is a discrepancy" is disclosed in Radziewicz-Reilly and Rainis according to the rationale of the claim 7 - 10 rejections. Since the rationale of the claim 7 - 10 rejections is incorrect, they are incorrect here as well. Hence, even if claim 24 was obvious from Radziewicz, in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 25. Therefore claim 25 should be allowed to issue.

Claim 26:

Claim 26 is dependent from claim 24. Therefore claim 26 should be allowed to issue for the same reasons as claim 24.

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The Examiner contended that Reilly, at 7:50-67 and 8:1-35, teaches the claimed feature, "verifying demographic information for the identified user stored at the access control system and providing the communication link." The Examiner's analysis is incorrect. Reilly, at 7:50-67 and 8:1-35, discusses "a set of procedures that define and update the subscriber's profile . . . [with regard to] . . . a subscriber identifier [and] a connection password." Reilly, at 7:50-67 and 8:1-35, does not discuss a verification process. Moreover, the subscriber identifier and connection password of Reilly are not indicative of "demographic information" of the claimed invention.

The Examiner contended that Reilly's Figures 2 and 5 teach the claimed feature, "collecting demographic information from the user computer in an initial registration and access operation, storing the demographic information at the access control system and identifying it with the registered user, and providing the communication link." The Examiner's analysis is incorrect. Reilly's Figures 2 and 5, at best, merely shows sports categories. There is nothing in Reilly's Figures 2 or 5 that even remotely relates to the claimed demographic report. Moreover, there is nothing in Reilly's Figures 2 or 5 that teach the claimed identifying step and the providing step.

The Examiner failed to address the claimed feature, "otherwise terminating the communication link and denying network access."

Therefore, even if claim 24 was obvious from Radziewicz, in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 26. Therefore claim 26 should be allowed to issue.

Claim 27:

Claim 27 is dependent from claim 26. Therefore claim 27 should be allowed to issue for the same reasons as claim 26.

The Examiner contended that Reilly's Figures 2 and 5 teach the claimed feature, "reporting the ad impression viewing data to the access control system." The Examiner's analysis is incorrect.

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There is nothing in Reilly's Figures 2 and 5 that teach the claimed feature. Hence, even if claim 26 was obvious from Radziewicz, in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 27. Therefore claim 27 should be allowed to issue.

Claim 28:

Claim 28 is dependent from claim 27. Therefore claim 28 should be allowed to issue for the same reasons as claim 27.

The Examiner contended that Reilly's Figure 2 teaches the claimed feature, "wherein the operations performed by the access control server further include preparing a Demographic Report that summarizes the reported ad impression viewing data for multiple computer users over a current time period." There is nothing in Reilly's Figure 2 that teaches the claimed feature. Hence, even if claim 27 was obvious from Radziewicz, in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 28. Therefore claim 28 should be allowed to issue.

Claim 29:

Claim 29 is dependent from claim 28. Therefore claim 29 should be allowed to issue for the same reasons as claim 28.

The Examiner contended that Reilly's Figure 2 teaches the claimed feature, "wherein the operations performed by the access control server further include providing the Demographic Report to a computer user identified as an ad file sponsor." There is nothing in Reilly's Figure 2 that teaches the claimed feature. Hence, even if claim 28 was obvious from Radziewicz, in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 29. Therefore claim 29 should be allowed to issue.

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Claim 30:

Claim 30 is dependent from claim 28. Therefore claim 30 should be allowed to issue for the same reasons as claim 28.

The Examiner contended that Reilly's Figure 5 teaches the claimed feature, "wherein the Demographic Report includes demographic report fields that are selected by the computer user." There is nothing in Reilly's Figure 5 that teaches the claimed feature. Hence, even if claim 28 was obvious from Radziewicz, in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 30. Therefore claim 30 should be allowed to issue.

Claim 31:

Claim 31 is dependent from claim 28. Therefore claim 31 should be allowed to issue for the same reasons as claim 28.

The Examiner contended that Reilly's Figure 2 teaches the claimed feature, "wherein the access control server further provides archival reports for prior time periods." There is nothing in Reilly's Figure 2 that teaches the claimed feature. Hence, even if claim 28 was obvious from Radziewicz, in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 31. Therefore claim 31 should be allowed to issue.

Claim 32:

Claim 32 is dependent from claim 28. Therefore claim 32 should be allowed to issue for the same reasons as claim 28.

The Examiner stated that the claimed feature, "wherein the operations performed by the access control server further include: comparing an ad file having an associated demographic profile with demographic data for each of multiple registered users and identifying those registered users

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having demographic information that matches the demographic profile for the ad file", is taught by the rationale of the claim 27 rejection. Since the rejection rationale of claim 27 is incorrect, it is incorrect here as well. Hence, even if claim 28 was obvious from Radziewicz, in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 32. Therefore claim 32 should be allowed to issue.

Claims 39 and 40:

Claims 39 and 40 depend from claim 33. Therefore claims 39 and 40 should be allowed to issue for the same reasons as claim 33.

The Examiner (a) asserted that claims 39 and 40 have similar limitations as claims 7 and 10 and (b) rejected claims 39 and 40 under the "same rationale as discussed above". The Examiner's rejection rationale in claims 7 and 10 is incorrect. Therefore it is incorrect here as well. Hence, even if claim 33 was obvious from Radziewicz, in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claim 39 and 40. Therefore claims 39 and 40 should be allowed to issue.

Claims 53-54:

Claims 53 depends from claim 47. Claim 54 depends from claim 53. Therefore claims 53 and 54 should be allowed to issue for the same reasons as claim 47.

The Examiner (a) asserted that claims 53-54 list all the same elements of claims 7 and 10, but in program product form rather than method form and (b) rejected claims 53-54 based on the claim 7 and 10 rejection rationale. Since the claim 7 and 10 rejection rationale is incorrect, it is incorrect here as well. Hence, even if claim 47 was obvious from Radziewicz, in view of Reilly and further in view of Rainis, the Examiner has not made a *prima facie* case of obviousness with regard to claims 53-54. Therefore claims 53-54 should be allowed to issue.

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Claim Rejections – Double Patenting

The Examiner rejected claims 1 – 60 under the judicially created doctrine of double patenting over claims 1 – 35 of U.S. Patent No. 6,463,468. A terminal disclaimer compliant with 37 C.F.R. § 1.321(c) is enclosed.

Conclusion


It is submitted, however, that the independent and dependant claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy and because agreement was reached with the Examiner as described above, the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Date: December 4, 2003


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Appendix